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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,911	06/14/2001	Max Aebi	8932-471	7179

7590 12/16/2003  
PENNIE & EDMONDS LLP  
1667 K Street, N.W.  
Washington, DC 20006

EXAMINER

REIP, DAVID OWEN

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/879,911

Applicant(s)

AEBI ET AL.

Examiner

David O. Reip

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-25 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-22, 27 and 29 is/are rejected.
- 7) ☒ Claim(s) 8, 26, 28 and 30-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/14/03 and 9/29/03  
is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed 9/29/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: New figure 8A and all amendments to the specification to support new figure 8A. Clearly, since the applicant found it necessary to add extensive amendments to the specification in order to provide an adequate written description of an alternative "double blade" embodiment of the embodiment of the removable blade distractor of Fig. 1, such amendments are prima facie evidence that the disclosure as originally filed did not provide adequate written description for an embodiment as shown in newly proposed Fig. 8A.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The claims in the instant application are directed to the embodiment of the distractor as shown in Figs. 14-16, i.e. a distractor having a set of blades (hereinafter "double blades") associated with each jaw. Figs. 14-16 only show the double blades integrally attached to their respective jaws, such feature being recited in claim 6. However, claims 7, 9-16, 27, and 29 are directed to features associated with detachable blades, such features not shown in the

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drawings in combination with the double blades embodiment. Further, with respect to claim 5, blades of different length are not shown in combination with the double blades embodiment. Further, with respect to claim 19, the blades extending at an angle range of 20-30 degrees relative to the longitudinal axis of the distractor mechanism are not shown in combination with the double blades embodiment. Therefore, the limitations recited in claims 5, 7, 9-16, 19, 27, and 29 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 26-32 are objected to because of the following informalities: In claim 26, line 13, "wherein the first plane is angle with respect to the second plane" should be amended to read --wherein the first plane is *angled* with respect to the second plane-- (italics added to emphasize the amended word). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5, 7, 9-16, 19, 27, and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See explanation above with respect to the objection to the drawings.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-4, 6, 17, 18, and 20-22 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ray (WO 98/34552). Figs. 6, 7, and 8B of Ray show a distractor device having all the limitations as recited in claims 1-4, 6, 17, 18, and 20-22, including: first and second handles 25; first and second jaws 22, the jaws including at least one curved portion (see area of 33 in Fig. 8B); first and second sets of spaced, integrally attached blades 32, the tips of the blades being curved, thus "including at least one curved portion" (see Fig. 8B); and a distractor mechanism 26-29.

Under the law of anticipation, it is necessary only that the claim in question "read on" the reference. As to functions recited, it is necessary only that the prior art be "capable of" performing the intended function. That being the case, claims 1-4, 6, 17,

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18, and 20-22 read on Ray and are therefore anticipated. The blades 32 of Ray are fully capable of being inserted between adjacent vertebrae in direct contact with the vertebral bodies ("anatomical elements"). Subsequent operation of the Ray distractor would distract the vertebrae to permit insertion of an implant.

### ***Allowable Subject Matter***

Claims 23-25 are allowed.

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 26, 28, and 30-32 are objected to for the minor informality in claim 26, but would be allowable if claim 26 were amended to correct the recited error.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

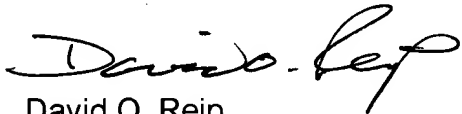
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David O. Reip at (703) 308-3383. The examiner can normally be reached Mon-Thu and every other Fri from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano, can be reached at (703) 308-2496. The official fax number for this Technology Center is (703) 872-9306. The examiner can also receive unofficial direct-to-computer faxes at 703-746-3310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at (703) 308-0858.



David O. Reip  
Primary Examiner  
December 13, 2003